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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,510	02/16/2006	Jan Buberl	06900128PUS1	1191
2292 7590 05/22/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
BROOKS, KRISTIE LATRICE				
ART UNIT		PAPER NUMBER		
1616				
NOTIFICATION DATE		DELIVERY MODE		
05/22/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/568,510

**Applicant(s)**

BUBERL ET AL.

**Examiner**

KRISTIE L. BROOKS

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)  
Paper No(s)/Mail Date 8/30/7: 2/16/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application***

1. Claims 1-14 are pending.

### ***Specification***

2. The abstract of the disclosure is objected to because it is too long. The abstract should be between 50-150 words in length. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara et al., Flower Induction in Asparagus Seedlings by Anilide and Benzamide derivatives, *Journal of Agricultural Food Chemistry*, 40, pg 1692-1694, 1992.

Hara et al. discloses two series of anilides (N-phenylalkanamides) and N-alkylbenzamides induced flowering, germination and emergence in 1-month-old seedlings of *Asparagus officinalis* L (see the abstract and introduction). The compounds are found to be more effective at flower inducing than the previously evaluated s-triazine

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and carbamate compounds (see the introduction). The compounds have the structural formula



(see Tables 1 and 2). The method of flower induction involved germinating the seeds in the presence of the compounds and planting the seeds in vermiculite (see the abstract and materials and methods). With regard to the preamble, i.e. a method of treating plants in need of growth promotion, it is the Examiner's position that since the prior art method and the instant method have the same results, i.e. growth promotion, the instant limitation is inherently met.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

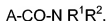
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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6. Claims 1-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken et al. (US 6,143,745).

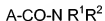
Applicant claims a method for treating plants in need of growth promotion, comprising applying to said plants, to the seeds from which they grow or to the locus in which they grow, a non-phytotoxic, effective plant growth promoting amount of an amide compound having the formula I



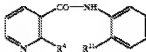
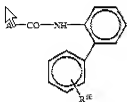
#### Determination of the scope and content of the prior art

##### (MPEP 2141.01)

Eicken et al. teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I



(see the abstract, column 2 lines 63-67 and column 3 lines 1-26). The compositions can preferably contain a compound of formula Ia or Ib



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(see column 7 and column 8 lines 1-35). The method for controlling fungi comprise treating plants, seed, soils with a composition of the invention (see column 8 lines 35-42). The weight ratio of the carrier to the amide compounds is 20:1 to 1:20 (see column 8 lines 30-34). The active is present in an amount of 0.1 to 95% (see column 10 lines 63-65). The compositions can be applied by spraying, dusting, etc and formulated in granules (see column 8 lines 43-48). The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 10 lines 30-35). The fungicidal composition can be applied at rates from 0.002 to 3 kg, of active compound per ha (see column 10 lines 66-67). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 11 lines 8-9). Examples of fungicides include strobilurins, such as methyl E-methoximino-[ $\alpha$ -(o-tolyloxy)-o-tolyl]acetate, methyl E-2-[2-[6-(2-cyanophenoxy)pyrimidin-4-yloxy]phenyl]-3-methoxyacrylate, methyl E-methoximino-[ $\alpha$ -(2,5-dimethyloxy)-o-tolyl]acetamide (see column 12 lines 54-58). The compounds of the invention can be applied together, separately, or in succession (see column lines 40-41).

**Ascertainment of the difference between the prior art and the claims****(MPEP 2141.02)**

Eicken et al. do not specifically recite the instant method of use. Eicken et al. do not teach an exemplification of the applying a compound of formula I and a strobilurin to plants.

**Finding of prima facie obviousness**  
**Rational and Motivation (MPEP 2142-2143)**

One of ordinary skill in the art would have been motivated to use the instant compounds in the method instantly claimed because Eicken et al. suggests the compounds are useful in controlling fungi. Although Eicken et al. do not specifically recite treating plants in need of growth promotion, one of ordinary skill can reasonably be assumed that plants in need of treatment against fungi are in need of growth promotion, since if the plants are not treated against the harmful fungi, they would be destroyed.

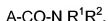
Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the instant compounds to help plants in need of growth promotion because by treating the plants against fungal attacks that may damage crops, one of ordinary skill would inherently be increasing plant growth.

Although Eicken et al. do not exemplify the application of a compound of formula I and a strobilurin, it would have been obvious to one of ordinary skill in the art since Eicken et al. suggests that the combination of compounds of formula I and other fungicides such as strobilurins can broaden the spectrum of fungicidal activity. Thus, one of ordinary skill would have used the combination if one wanted to broaden the protection against fungi.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

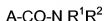
7. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eicken et al. (US 6,143,745) in view of Asrar et al. (US 2003/0060371).

Applicant claims a method for treating plants in need of growth promotion, comprising applying to said plants, to the seeds from which they grow or to the locus in which they grow, a non-phytotoxic, effective plant growth promoting amount of an amide compound having the formula I



**Determination of the scope and content of the prior art**  
**(MPEP 2141.01)**

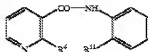
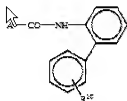
Eicken et al. teach compositions and methods for controlling fungi containing a solid or liquid carrier and at least one amide compound of formula I



(see the abstract, column 2 lines 63-67 and column 3 lines 1-26). The compositions can preferably contain a compound of formula Ia or Ib



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(see column 7 and column 8 lines 1-35). The method for controlling fungi comprise treating plants, seed, soils with a composition of the invention (see column 8 lines 35-42). The weight ratio of the carrier to the amide compounds is 20:1 to 1:20 (see column 8 lines 30-34). The compositions can be applied by spraying, dusting, etc and formulated in granules (see column 8 lines 43-48). The compositions are effective in protecting crops such as grass, fruit, and vegetables and the seeds of the plants (see column 10 lines 30-35). The fungicidal composition can be applied at rates from 0.002 to 3 kg, of active compound per ha (see column 10 lines 66-67). The compounds of the invention can be combined with other fungicides to increase fungicidal spectrum (see column 11 lines 8-9). Examples of fungicides include strobilurins, such as methyl E-methoximino-[ $\alpha$ -(o-tolyloxy)-o-tolyl]acetate, methyl E-2-[2-[6-(2-cyanophenoxy)pyrimidin-4-yloxy]phenyl]-3-methoxyacrylate, methyl E-methoximino-[ $\alpha$ -(2,5-dimethyloxy)-o-tolyl]acetamide (see column 12 lines 54-58). The compounds of the invention can be applied together, separately, or in succession (see column lines 40-41).

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Eicken et al. do not teach the ratio of the amide compound to a strobilurin. Eicken do not teach strobilurin, pyraclostrobin. However, Asrar et al. teach strobilurins, such as pyraclostrobin present in fungicidal compositions in the amount of 0.01 to 95%.

Asrar et al. teach methods of improving the yield and vigor of plants by protection against fungal plant pathogens with a compositions comprising active agents such as strobilurin fungicides, diazole, and triazole fungicides (see the abstract). Examples of strobilurin type fungicides include azoxystrobin, dimoxystrobin, famoxadone, kresoxim-methyl, metominostrobin, picoxystrobin, pyraclostrobin and trifloxystrobin (see page 5 paragraph 52). The active ingredient can be present in the amount of 0.01 to 95% (see page 17 paragraph 366).

### **Finding of prima facie obviousness**

#### **Rational and Motivation (MPEP 2142-2143)**

One of ordinary skill in the art would have been motivated to use the instant ratio of 20:1 to 1:20 for the compound of formula I and a strobilurin, because Eicken et al. suggests compounds of formula I can be combined with strobilurins. Although Eicken et al. do not teach the amount of strobilurins that present, Eicken et al. suggests the compounds of formula I can be present in the amount of 0.01 to 95% and it is already know in the art that strobilurins can be present in the amount of 0.01 to 95% by weight in fungicidal compositions as suggested by Asrar et al.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the instant ratio, because both the compounds of formula I and strobilurins can be present in various amounts in fungicidal compositions as suggested by both Eicken et al. and Asrar et al. and it is merely process optimization, in which one of ordinary skill in the art would vary the amount of active components necessary in order to achieve success results.

Although Eicken et al. do not teach strobilurin, pyraclostrobin, it would have been obvious to one of ordinary skill in the art to use pyraclostrobin because it is an obvious variation of strobilurins that can be used in fungicidal compositions as suggested by Asrar et al.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

### ***Conclusion***

8. No claims are allowed.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie L. Brooks whose telephone number is (571) 272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616